

REMARKS/ARGUMENTS

Claims 1-35 of the present application were previously canceled. Claim 36-46 are pending and rejected. By this Response, claims 37 and 39 are canceled and claim 36 is amended.

35 U.S.C. §112

Claims 36-46 were rejected under 35 U.S.C. §112, first paragraph, because, according to the Examiner, "the specification, while being enabling for rasp having a handle accepted by a hollow shaft of a chisel, does not reasonably provide enablement for a chisel that simply slides over the handle of a rasp in such a way as to not require the chisel to encompass the handle of the rasp."

Claim 36 has been amended to recite "a chisel including a hollow shaft that receives the rasp." Support is provided for this amendment in the specification at page 15, lines 30 – page 16, line 2, which state that "an internal hollow bore 527 [of the cutting instrument] extends from the proximal end 515 through the instrument 510 to the distal end 516 to receive a rasp 600." Claim 1 as amended is thus fully enabled by the specification. Reconsideration and withdrawal of the rejection of claims 36 and dependent claims 37-46 is respectfully requested.

35 U.S.C. §103

Claims 36-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Winslow et al. (U.S. 6,083,225) in view of Hamada (U.S. 6,436,101). Combination of Winslow and Hamada, however, does not teach, disclose or suggestion the invention as claimed. In fact, Winslow specifically teaches away from the construction on which the rejection is based.

Claim 36, as amended, is directed to a kit for preparing an implant region between adjacent first and second bone surfaces. The kit includes "a rasp including a rasp head and a handle" and "a chisel including a hollow shaft that receives the handle of the rasp and

spaced-apart first and second cutting edges adapted to slide over opposite first and second sides of the rasp head."

Winslow is directed to a surgical retractor 10 defining a longitudinal opening extending therethrough to receive surgical instrumentation. *See Col. 5, lines 34-35.* The retractor 10 further includes first and second arms 20, each having first and second vertebrae supporting surfaces 20a, 20b. *See Col. 5, lines 59-60.* Each arm 20 further includes tapered end portions 23 that facilitate insertion of retractor arms 20 within the intervertebral space. *See Col. 6, lines 11-15.*

Hamada is directed to rasp 501 for removing fibrocartilagenous material from the surfaces of the end plates and for shaping the end space. *See Col. 29, lines 5-7.*

Winslow fails to disclose a chisel having "spaced-apart first and second cutting edges" as recited in claim 36. While the Examiner asserted that the Winslow surgical retractor 10 "could be used as a chisel due to its blade (20)," this position ignores the explicit teachings of Winslow to the contrary. Specifically, the Winslow retractor, as the name implies, is intended to be used as a retractor, not as a chisel or cutting tool. The Winslow retractor does not include blades, as asserted by the Examiner, but rather is provided with "retractor arms 20" each having "vertebral supporting surfaces 20a, 20b." *See Col. 5, lines 66-67.* A driving instrument is employed to insert the retractor 10 within the bony tissue, which "drives the arms 20...into the disc space (with the height h [the distance between the arms 20] spanning the space) and distracts the opposing vertebrae bodies as surfaces 20a engage the upper (or lower) vertebrae body and surface 20b engages the opposing vertebral body." *See Col. 6, lines 20-26.*

Winslow thus requires that the arms 20 separate and support the vertebrae. If the retractor arms 20 were "blades" as suggested by the Examiner, having cutting edges, they would cut into the vertebrae rather than distract them, eviscerating the functionality of the Winslow device. Thus, Winslow teaches away from a chisel having "spaced-apart first and second cutting edges" according to the claimed invention. Because neither Winslow nor Hamada, alone or in combination, teaches or suggests all of the elements of claim 36, the

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requirements of 35 U.S.C. §103(a) are not met. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 38 and 40-46 depend from claim 36 and are allowable for at least the same reasons. Reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

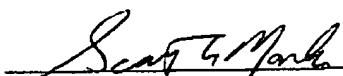
All of the claims remaining in this application should now be seen to be in condition for allowance. The prompt issuance of a notice to that effect is respectfully solicited. If there are any remaining questions, the Examiner is requested to contact the undersigned at the number listed below.

No fee is believed to be necessary for the entry of this paper. Should any fee be required for entry of this paper, the Commissioner is authorized to charge the Faegre & Benson Deposit Account No. 06-0029 and in such event, is requested to notify us of the same.

Respectfully Submitted,

DAVID A. HANSON et al.

By:



Scott A. Marks, #44,902
FAEGRE & BENSON LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
612/766-7820

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